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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,536	03/29/2005	Yasuhito Yuasa	10873.1640USWO	4552

7590 07/16/2008  
Hamre,Schumann,Meuller&Larson,P.C.  
P.O. Box 2902-0902  
Minneapolis, MN 55402

EXAMINER
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RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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07/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,536	<b>Applicant(s)</b> YUASA ET AL.	
	<b>Examiner</b> Christopher RoDee	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,8,9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,8,9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Claim Rejections - 35 USC § 112***

Claims 1, 2, 4, 8, 9, and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the last Office action the Examiner took the position that the use a polyester resin in the binder resin of the toner is only disclosed where combined with a wax and where the polyester has the characteristics specified in ¶ [0054] in the application's PGPub '695 (also see spec. pp. 14-17) noting the various molecular weight characteristics, melting property, flow property, and glass transition temperature (see p. 15, l. 18 forward).

In response to this rejection applicants have amended the instant claims to specify the wax and that the polyester is formed by reaction of an alcohol component and a carboxylic acid component (spec. p. 17, l. 4-7). This passage in the specification discusses "the binding resin that preferably is used in this embodiment is a polyester obtained by a condensation polymerization between an alcohol component and a carboxylic component." However, the binding resin of "this embodiment" also has the characteristics specified in ¶ [0054]. Specifically, this passage states,

"The binding resin of this embodiment contains a polyester resin in which at least one molecular weight maximum peak is in a region of  $2 \times 10^3$  to  $3 \times 10^4$  in a molecular weight distribution measured with GPC, in which the content of components in the high molecular weight region with a molecular weight of at least  $3 \times 10^4$  is at least 5% with respect to the entire binding agent, in which the weight-average molecular weight ranges from 10,000 to 500,000, in

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which the Z-average molecular weight ranges from 20,000 to 5,000,000, in which the ratio between the weight-average molecular weight and the number-average molecular weight (weight-average molecular weight / number-average molecular weight) ranges from 3 to 150, in which the ratio between the Z-average molecular weight and the number-average molecular weight (Z-average molecular weight / number-average molecular weight) ranges from 10 to 2000, in which the melting temperature (hereinafter, referred to as the softening point) ranges from 80 to 150°C measured by the 1/2 method with a capillary rheometer flow tester of a constant pushing force type, in which the flow-beginning temperature ranges from 80 to 20°C, and in which the glass transition point of the resin ranges from 45 to 68°C.”

The claims as now presented do not include the other characteristics disclosed as essential to the embodiment.

Further, new claim 14 does not have basis for the “trimellitic acid” specified.

The claims as presented contain new matter because they do not present the polyester resin as described in the specification. See the last Office action for additional basis for this rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/  
Primary Examiner  
Art Unit 1795

16 July 2008